

REMARKS/ARGUMENTS

The instant invention is drawn to compositions that are useful as sprayable hot melt adhesives. These compositions show improved adhesion after storage and improved wet adhesion (page 3, lines 7-14). The properties of prior commercial adhesives tend to deteriorate when stored (page 2, lines 10-11). In addition, a marked reduction in adhesion is found when these products are used in a wet state (page 2, lines 11-13). The instant invention improves the aforementioned properties by using novel compositions comprising a mixture of poly- α -olefins having a softening point of 70°C to 130°C, a needle penetration of 0.8 to 4.0 mm as measured in accordance with DIN 52010, and a melt viscosity at 190°C of 1,000 mPas to 20,000 mPas. In addition, the instant compositions comprise at least one oil having a viscosity of 20 to 300 mPas at 20° C; and at least one hydrocarbon resin having a softening range of 70°C to 140°C (page 3, line 15 to page 4, line 15).

Claims 15-35 are pending. The specification is amended to correct a typographical error that occurred during the translation from the priority document. The needle penetration value of "0.8 to 4.0 mm" was mistakenly listed as "8 to 4.0 mm" in the substitute translation submitted to the Patent Office on August 24, 2001. The instant amendment presents the correct value. The basis for the amendment can be found at page 3, last paragraph of the PCT priority application. Claims 15 and 34 are also amended to reflect the correct needle penetration value.

Claims 15-35 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. As discussed above, the specification is amended to correct a typographical error in the translation from the original priority document. At page 3, line 22 of filed specification the needle penetration is amended to read "0.8 to 4.0 mm." Claims 15 and 34 are amended to reflect this range. Based on this amendment, Applicants respectfully request reconsideration and withdrawal of the rejection.

Claims 15-20 and 22-35 are rejected under 35 U.S.C. § 103(a) as allegedly obvious over U.S. Patent No. 5,763,333 ("the Suzuki patent") in view of either U.S. Patent No. 5,723,546 ("the Sustic patent") or U.S. Patent No. 5,804,519 ("the Riswick patent"). Applicants traverse this rejection. As acknowledged by the Office Action (page 4), Suzuki does not disclose a mixture of poly- α -olefins. The Office Action seeks to remedy this defect

by using the teachings of the Sustic patent or the Riswick patent. Before a rejection for alleged obviousness can be predicated on a "combination of references," however, some motivation to combine the teachings of the prior art must be identified. An invention is not obvious under the patent laws simply because it is theoretically possible with the aid of hindsight to combine references in a manner that will yield the claimed invention. The prior art itself must suggest the desirability of the modification. *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). In other words, "the examiner must show reasons that the skilled artisan, confronted with the same problem as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998).

The combination of art proposed in the Office Action lacks proper motivation. The Suzuki patent discloses that any poly- α -olefin (APAO) can be used (column 7, lines 39-40). There is no guidance or suggestion that directs one skilled in the art to choose a mixture of APAOs with the specific characteristics of the APAOs of the instant claims. At most, the disclosure of the Suzuki patent is an invitation to experiment and the instant invention is only obvious when the art is viewed with the Applicant's blueprint.

Even if one were to combine the cited art, significant picking and choosing is needed to arrive at any claimed invention. Not only does one have to select a *mixture* of APAOs, one must select APAOs with the properties of those of the instantly claimed invention. Next, one would have to select a specific thin-flowing oil with a melt viscosity of 20 to 300 mPas at 20°C. At column 7, lines 49 to column 8, line 12, the Suzuki patent discloses a broad range of optional "softeners" which can be used in their compositions. The viscosity range of the instantly used oil is not disclosed or suggested. To arrive at the instantly claimed compositions, one would also have to select hydrocarbon resins with a softening range of from 70 to 140°C. The teaching of the Suzuki patent (column 7, lines 53-65) is broad and does not suggest the softening range of the resin of the instant claims.

By selecting the aforementioned components, the compositions of the instant invention show improved wet strength (page 3, lines 7-9 of the specification). The Suzuki patent does not disclose such a composition. Nor does the Suzuki patent suggest that such compositions would show improved wet strength. In fact, by teaching that any APAO can be

used, the Suzuki patent gives no hint that the mixture of APAOs with certain properties are important for improving wet strength.

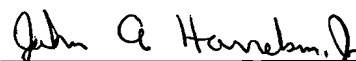
The Sustic patent also does not teach that the instant specific blend of APAOs is compatible with thin flowing oils and specific hydrocarbon resins. In fact, the Sustic patent shows a preference for high melting points of the blends (column 8, line 33-38). Thus, even if one skilled in the art had been aware of both the Suzuki and Sustic patents, there is nothing in them to compel the design of the instantly claimed invention. As such, Applicants respectfully ask for reconsideration and withdrawal of the rejection.

The Riswick patent also does not render the instant claims obvious. While the Riswick patent may show certain APAOs used in the instant specification, it does not teach a blend of APAOs that have the properties of the instant compositions. Further, as with the Sustic patent, the Riswick patent does not show that such compositions show improved wet strength, nor that the instant specific blend of APAOs is compatible with the thin flowing oils and specific hydrocarbon resins. For reasons analogous to those discussed for the Sustic patent, the Applicant's blueprint is necessary to arrive at any claimed invention. As such, reconsideration and withdrawal of the rejection is respectfully requested.

Applicants believe that the foregoing constitutes a complete and full response to the Office Action of record. Accordingly, an early and favorable reconsideration of the rejections and an allowance of all of pending claims is earnestly solicited.

Respectfully submitted,

Date: May 19, 2004



John A. Harrelson, Jr.
Registration No. 42,637

Woodcock Washburn LLP
One Liberty Place - 46th Floor
Philadelphia PA 19103
Telephone: (215) 568-3100
Facsimile: (215) 568-3439